



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,224	10/22/2003	Shigeru Nemoto	WAKAB60.001DV3	8362

20995 7590 04/24/2006

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

WILLIAMS, CATHERINE SERKE

ART UNIT	PAPER NUMBER
----------	--------------

3763

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary	Application No. 10/691,224	Applicant(s) NEMOTO, SHIGERU	
	Examiner Catherine S. Williams	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/27/06; 3/27/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 1/27/06 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 9105980.1.

It is first noted that the claims are drawn to a syringe barrel. The barrel can be mounted on a cylinder holder that comprises a flange insertion groove. See claim 1. The prior art does not have to teach a cylinder holder. The prior art only has to be capable of use with a cylinder holder as claimed in claims 1 and 3-4.

Art Unit: 3763

DE '980.1 teaches a syringe barrel (10) that includes a flange (16) and a guide (28). The syringe is used for injecting liquid medicines into a patient. Regarding the intended use of the claims, the prior art as shown in figures 1-3 is capable of being used as claimed. The flange is capable of being held by a flange insertion groove in a cylinder holder. The guide (28) as shown in figure 3 has a thickness that could be prevented from fitting in a narrow flange insertion groove that only accepted the very tip of the flange. If prevented from fitting in the flange, the guide would prevent rotation since the guide is a linear projection and would abut against a vertical wall of the groove. The prior art syringe could also be used with a cylinder holder that has two clamps.

Claims 1,3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Aguilar (USPN 5,833,668).

It is first noted that the claims are drawn to a syringe barrel. The barrel can be mounted on a cylinder holder that comprises a flange insertion groove. See claim 1. The prior art does not have to teach a cylinder holder. The prior art only has to be capable of use with a cylinder holder as claimed in claims 1 and 3-4.

Aguilar teaches a syringe barrel (1) that includes a flange (7) and a guide (6). The syringe is used for injecting liquid medicines into a patient. Regarding the intended use of the claims, the prior art as shown in figure 1 is capable of being used as claimed. The flange is capable of being held by a flange insertion groove in a cylinder holder. The guide (6) as shown in figure 1 has a thickness that could be prevented from fitting in a narrow flange insertion groove that only accepted the flange (7). If prevented from fitting in the flange, the guide would

Art Unit: 3763

prevent rotation since the guide is a linear projection and would abut against a vertical part of the cylinder holder. The prior art syringe could also be used with a cylinder holder that has two clamps.

Claims 1,3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Nevens et al (USPN 5,226,897).

It is first noted that the claims are drawn to a syringe barrel. The barrel can be mounted on a cylinder holder that comprises a flange insertion groove. See claim 1. The prior art does not have to teach a cylinder holder. The prior art only has to be capable of use with a cylinder holder as claimed in claims 1 and 3-4.

Nevens teaches a syringe barrel (11) that includes a flange (13) and a guide (36). The syringe is used for injecting liquid medicines into a patient. Regarding the intended use of the claims, the prior art as shown in figures 1 is capable of being used as claimed. The flange is capable of being held by a flange insertion groove in a cylinder holder. The guide (lateral most part of element 36 that has a larger thickness than the medial part of the flange) a thickness that could be prevented from fitting in a narrow and short flange insertion groove that only accepted the very medial portion of the flange. If prevented from fitting in the flange, the guide would prevent rotation since the guide is a linear projection and would abut against a lateral vertical wall of the groove. The prior art syringe could also be used with a cylinder holder that has two clamps.

Art Unit: 3763

Claims 1,3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Nerney (USPN 6,368,308).

It is first noted that the claims are drawn to a syringe barrel. The barrel can be mounted on a cylinder holder that comprises a flange insertion groove. See claim 1. The prior art does not have to teach a cylinder holder. The prior art only has to be capable of use with a cylinder holder as claimed in claims 1 and 3-4.

Nerney teaches a syringe barrel (16) that includes a flange (22) and a guide (30). The syringe is used for injecting liquid medicines into a patient. Regarding the intended use of the claims, the prior art as shown in figure 2 is capable of being used as claimed. The flange is capable of being held by a flange insertion groove in a cylinder holder. The guide (30) as shown in figure 2 has a thickness that could be prevented from fitting in a flange insertion groove that only accepted the flange. If prevented from fitting in the flange, the guide would prevent rotation since the guide is a linear projection and would abut against a vertical wall of the cylinder holder. The prior art syringe could also be used with a cylinder holder that has two clamps.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine S. Williams whose telephone number is 571-272-4970. The examiner can normally be reached on Monday - Friday.

Art Unit: 3763

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine S. Williams

April 21, 2006